



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,721	03/11/2004	D. Wade Walke	LEX-0477-USA	5023

7590 04/12/2005

Lance K. Ishimoto
LEXICON GENETICS INCORPORATED
8800 Technology Forest Place
The Woodlands, TX 77381

EXAMINER

LI, RUIXIANG

ART UNIT PAPER NUMBER

1646

DATE MAILED: 04/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/798,721	Applicant(s) WALKE ET AL.	
	Examiner Ruixiang Li	Art Unit 1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,7 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03/11/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DL

DETAILED ACTION

Election/Restrictions

1. Applicants' election without traverse to prosecute the claims (claims 1, 7, and 8) drawn to the nucleic acid molecule of SEQ ID NO: 9 in a response filed on 03/14/2005 is acknowledged.
2. Applicants' preliminary amendment to the specification filed on 03/11/2004 has been entered. Applicants' amendment filed on 03/14/2005 has also been entered in full. Claims 2-6 have been canceled. Claims 1, 7, and 8 are pending and are under consideration.

Information Disclosure Statement

3. The information disclosure statement filed on 03/11/2004 has been considered by the Examiner and a signed copy has been attached to this office action.

Claim Rejections—Nonstatutory Obviousness-Type Double Patenting

4. Basis for nonstatutory double patenting:

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the

Art Unit: 1646

conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 7, and 8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, and 6 of U.S. Patent No. 6,777,232. Although the conflicting claims are not identical, they are not patentably distinct from each other because the nucleic acid molecule of SEQ ID NO: 9 is a species of the genus of nucleic acid molecules claimed in the instant application. In other words, claims 1, 4, and 6 of U.S. Patent No. 6,777,232 fall entirely within the scope of claims 1, 7, and 8 of the instant application.

Claim Rejections—35 USC § 112, 1st paragraph

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1, 7, and 8 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an isolated nucleic acid molecule comprising SEQ ID NO: 9, a recombinant expression vector comprising the nucleic acid molecule, and a host cell comprising the expression vector, does not reasonably provide enablement for an isolated nucleic acid molecule comprising at least 80 contiguous bases of nucleotide sequence from SEQ ID NO: 9, a recombinant expression vector comprising the nucleic acid molecule, and a host cell comprising the expression vector. The specification does not enable any person skilled in the art

to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The factors that are considered when determining whether a disclosure satisfies enablement requirement include: (i) the quantity of experimentation necessary; (ii) the amount of direction or guidance presented; (iii) the existence of working examples; (iv) the nature of the invention; (v) the state of the prior art; (vi) the relative skill of those in the art; (vii) the predictability or unpredictability of the art; and (viii) the breadth of the claims. *Ex Parte Forman*, 230 USPQ 546 (Bd Pat. App. & Int. 1986); *In re Wands*, 858 F. 2d 731, 8 USPQ 2d 1400 (Fed. Cir. 1988).

Claim 1 recites a genus of nucleic acid molecules of any size that has at least 80 contiguous nucleotides of SEQ ID NO: 9, whereas claims 7 and 8 recite a recombinant expression vector comprising the nucleic acid molecule and a host cell comprising the expression vector. However, other than SEQ ID NO: 9 that encodes SEQ ID NO: 10, the disclosure has not provided sufficient guidance and information regarding the structural and functional requirements commensurate in scope with what is encompassed by the instant claim. The disclosure has not shown (i) which portions of SEQ ID NO: 9 are critical to the activity of the protein of SEQ ID NO: 10; and (ii) what modifications (e.g., substitutions, deletions or additions) one can make to SEQ ID NO: 9 will result in protein mutants with the same functions as the protein of SEQ ID NO: 10. The state of the art (See, e.g., Ngo, et al, *The Protein Folding Problem and Tertiary Structure Prediction*, 1994, Merz, et al. (ed.), Birkhauser, Boston, MA, pp. 433 and 492-495) is such that the relationship between sequence of

a protein and its activity is not well understood and is not predictable. Excising out portions of a protein or modifications to a protein, e.g., by substitutions or deletions, would often result in deleterious effects to the overall activity and effectiveness of the protein.

Accordingly, the disclosure fails to enable such a myriad of the claimed nucleic acid molecules that not only vary substantially in length but also in nucleotide composition and to provide any guidance to those skilled generally on how to make and use the claimed genus of nucleic acid molecules. Thus, it would require undue experimentation for one skilled in the art to make and use the claimed genus of nucleic acid molecules embraced by the instant claim.

8. Claims 1, 7, and 8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

The specification discloses a nucleotide sequence set forth in SEQ ID NO: 9, which encodes a polypeptide of SEQ ID NO: 10. However, claim 1 recites a genus of nucleic acid molecules comprising at least 80 contiguous nucleotides of SEQ ID NO: 9. Thus, it encompasses virtually any random sequence of any length as long as it has a stretch of at least 80 consecutive nucleotides that is the same as SEQ ID NO: 9. Claims 7 and 8 recite a recombinant expression vector comprising the nucleic acid molecule and a host cell comprising the expression vector.

The instant disclosure of a single species of nucleic acid of SEQ ID NO: 9 that

encodes SEQ ID NO: 10 does not adequately support the scope of the claimed genus, which encompasses a substantial variety of subgenera including full-length genes. A description of a genus of cDNA may be achieved by means of a recitation of a representative number of cDNAs, defined by nucleotide sequence, falling within the scope of the genus, or of a recitation of structural features common to the genus, which features constitute a substantial portion of the genus. *Regents of the University of California v. Eli Lilly & Co.*, 119 F3d 1559, 1569, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997). The instant disclosure fails to provide sufficient description information, such as definitive structural or functional features of the claimed genus of nucleic acid molecules or polypeptides. There is no description of the conserved regions that are critical to the structure and function of the genus claimed. There is no description of the sites at which variability may be tolerated and there is no information regarding the relation of structure to function. Furthermore, the prior art does not provide compensatory structural or correlative teachings to enable one skilled in the art to identify the encompassed nucleic acid molecules as being identical to those instantly claimed.

Due to the breadth of the claim genus and lack of the definitive structural or functional features of the claimed genus, one skilled in the art would not recognize from the disclosure that the applicant was in possession of the claimed genus.

Conclusion

9. No claims are allowed.

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruixiang Li whose telephone number is (571) 272-0875. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (571) 272-0829. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at the toll-free phone number 866-217-9197.

Ruixiang Li

Ruixiang Li, Ph.D.

Examiner

April 9, 2005